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EXAMINER

FISCHER, ANDREW J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/740,808

Applicant(s)

PINKUS, RON

Examiner

Andrew J. Fischer

Art Unit

3627

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. Applicant's amendment filed October 7, 2005 is acknowledged. Accordingly, claims 1-13 remain pending.
2. Claim 11 was withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on September 29, 2003.
3. This Office Action, the "Second Final Office Action" is given Paper No. 20051229.
4. All references in this Second Final Office Action to the capitalized versions of "Applicant" refers specifically the Applicant of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.
5. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Claim Rejections - 35 USC §112 1st Paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3627

7. Claims 1-10, 12, and 13 are rejected under 35 U.S.C. §112, 1st paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

8. In claims 1 and 2, the phrase the “vehicle presence detector performing automatic detection of a vehicle” is considered new matter. The Examiner has carefully reviewed the original specification and can not locate where Applicant discloses that the presence of the vehicle is detected automatically. The Examiner notes that while the original specification directly discloses that the “windshield tags automatically supply information to the RLC 301 via a wireless electronic interface between the user’s vehicle tag and the antenna,” this is not necessarily performing automatic detection since the RLC 301 could read the tag if a user presented the tag while on foot. In other words, the specification is silent as to how the system initiates detection of a vehicle—it does not disclose that the process is necessarily automatic. While the Examiner concedes that the “vehicle presence detector performing automatic detection of a vehicle” is most likely to occur and therefore may be *obvious* in view of the original disclosure, it is nevertheless not *necessarily* present because the user could simply activate the system with a manual switch which would in turn “automatically supply information to the RLC 301 via a wireless electronic interface. . . .”

9. Like all new matter rejections, if Applicant can expressly point out where in the original specification the offending phrase is found, the new matter rejection(s) will be withdrawn.

Claim Rejections - 35 USC §102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Second Final Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-10, 12, and 13, as understood by the Examiner, are rejected under 35

U.S.C. §102(e) as being anticipated by Smith et. al. (U.S. 6,236,314 B1) (“Smith ‘314”),

Christman et. al. (U.S. 6,390,151 B1), and Baric (U.S. 6,527,176).¹ Smith ‘314 discloses a

system 10 including that a presence detector whereby the detection process may rely on

reflection of electromagnetic waves, detection of magnetic anomalies, or the detection of a large

mass; a controller 14 which passes the information to one or more computers; an interrogator 13,

a receiver RX 28, an RFID transponder module 12 having an antenna (inherent in virtually all

RFID systems); and an automated fuel retail system (not illustrated) which uses the system 10

including the interrogator 13. The interrogator 13 exchanges signals with the transponder 12 that

is attached to vehicle (not illustrated) to determine whom to bill for fuel dispensed to that vehicle

when the vehicle is fueled at the fuel dispensing station. In Smith ‘314, the point of sale device

is the transaction mechanism associated with the fuel dispenser.

¹ See MPEP §2131.01 III expressly authorizing a multiple reference §102 rejection when the additional reference are used to show that which is inherent.

Art Unit: 3627

12. It is the Examiner's factual determination that Smith '314 also discloses "data is written to the tag in the form of the tag identification number" which is then correlated to a unique customer identification number and this tag identification number can be used for various purposes including but not limited to authentication and future transactions.

13. It is the Examiner's factual determination that Christman directly discloses a typical refueling transaction in the "Background of the Invention, subsection titled: "Description of Related Art," L1, C23 to C2, L18. Thus, Christman discloses, inter alia, the basics of a POS transaction at a fuel dispenser. And it is the Examiner's factual determination that Baric discloses the structure and features of an ordinary fuel dispenser that are very old and well known in the art.

14. Finally, because fuel stations almost always have fuel pumps for more than one vehicle, it is the Examiner's factual determination that Smith '314 inherently discloses a first vehicle presence detector is associated with a first fuel pump and a second first vehicle presence detector is associated with a second fuel pump, etc.

Claim Rejections - 35 USC §103

15. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Second Final Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3627

16. Claims 1-3, 5-8, 10, 12, and 13, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Smith '314 in view of Christman and Baric.²

It is the Examiner's principle position that the claims are anticipated because the additional references are used to simply show the inherent features including the structure and operation of ordinary fuel dispensers.

However for any reason a reviewing body finds that the claims are not anticipated, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Smith '314 as taught by Christman and Baric and to simply include those features from Christman and Baric that are old and well known in the art. Such a combination would have made Smith '314 a more complete disclosure. Additionally, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Smith '314 to include a first vehicle presence detector associated with a first fuel dispenser and a second first vehicle presence detector associated with a second fuel dispenser, etc. Such a modification would have simply allowed more than one fuel dispenser to be used. It would not make sense to have a one-to-many relationship.

Additionally, if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Smith '314 to include, before activating the first dispenser, the POS device validating the user tag. Such a modification would have helped prevent customers from stealing the fuel by requiring a guarantee of payment before dispensing the fuel.

² See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

Art Unit: 3627

17. Claim 4, as understood by the Examiner, is alternately rejected under 35 U.S.C. §103(a) as being unpatentable over Smith '314 in view of Hughes et. al. (U.S. 5,557,268) ("Hughes"). Smith '314 discloses as discussed above but is silent as to whether the invention uses a customer frequent purchase program. Hughes teaches a customer frequent purchase program which may include recording the number of previous visits to the establishment in order to provide promotional awards such as price discounts to frequent customers. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Smith '314 as taught by Hughes to include Hughes's customer frequent purchase program. Such a modification would have allowed the fueling establishment to provide promotional awards such as price discounts to frequent customers.

18. Claim 9, as understood by the Examiner, is alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Smith '314 in view of Tarranova (U.S. 6,157,871). Again, it is the Examiner's principle position that the claim 9 is anticipated because Smith '314 discloses a sticker RFID tags because Smith '314 directly discloses that the transponder module 12 is typically a dash-mounted unit. It is the Examiner's factual determination that dash mounted units are sticker RFID tags because if they are not "stuck to the dash or window, they will fly around the interior of the vehicle. Thus a sticker RFID tag provides the best method for accessing the transponder module since placing the RFID tag on the windshield is clearly preferable because the communications pass only through the windshield and not other parts of the vehicle.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Smith '314 as taught by Tarranova to include Tarranova's sticker mounted transponder. Such a modification would have provided the

Art Unit: 3627

clearest access to the transponder ensuring a “clean” communications and prevented the RFID tag from dangerously moving about the interior of the vehicle. In fact, it is the Examiner’s factual determination that vehicle-based decal sticker RFID tags are old and well known in the art. See *e.g.* Scott *et. al.* (U.S. 6,121,880); and Mays *et. al.* (U.S. 6,275,157).

19. It is the Examiner’s factual determination that there are at least three (3) basic types of RFID tags known to those skilled in this art: passive RF tags, active tags without a battery, and active tags with a battery. See *e.g.* Ghaem *et. al.* (U.S. 5,495,250) C1, L45 to C2, L24 for a discussion of the strengths and weaknesses of these three (3) types of tags.

20. Additionally, it is the Examiner’s factual determination that using vehicle presence detectors to initiate RFID tag read/write sessions to complete a transaction are old and well known in the art. See *e.g.* Hassett *et. al.* (U.S. 5,252,162); Jesadanont (U.S. 5,451,758); Hassett (U.S. 5,805,082); Smith *et. al.* (U.S. 6,236,314 B1); and Greeff *et. al.* (U.S. 6,255,993 B1). By initiating the RFID only after the vehicle is detected, the power consumption of the RFID transceiver(s) can be reduced since they need only be energized or provided power *after* or upon detection of a vehicle.

21. For due process purposes and because Applicant has not objectively indicated and redefined claim limitation(s) to have meanings other than their ordinary and accustomed meanings, the Examiner confirms that Applicant has decided not to be his own lexicographer. To support this position, the Examiner again notes the following factual findings as first discussed in the previous Office Actions.³ First, the Examiner has again carefully reviewed the

³ See the First Non Final Office Action mailed October 31, 2003, Paragraph No. 12; First Final Office Action mailed July 14, 2004, Paragraph No. 11; and the Second Non Final Office Action mailed April 7, 2005, Paper No. 03102005, Paragraph No. 8 which begins on page 4.

Art Unit: 3627

specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements⁴ with the required clarity, deliberateness, and precision.⁵ Third, after receiving express notice of the Examiner's position that lexicography is *not* invoked,⁶ Applicant's three (3) responses have not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicant did not argue lexicography *was* invoked). Forth and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation⁷ to be his own lexicographer. Finally, after receiving express notice of the preceding factual findings and conclusions, Applicant's latest response again fails to point out the supposed errors in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R.

⁴ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁵ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁶ See Note 3.

⁷ See *e.g. Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants' failure to correct the examiner's characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant declined the examiner's express invitation to correct a possible error in claim interpretation: "applicant's attention was called to the examiner's interpretation of [how the element was interpreted by the examiner, and] applicant was invited to correct the examiner's interpretation—an invitation the applicant did not accept."

Art Unit: 3627

§1.111(b). Moreover, Applicant's latest response—while fully considered by the Examiner—has not changed the Examiner's reasonable conclusion that Applicant has decided not to be his own lexicographer. Therefore (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is again confirmed. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), and the Examiner continues to rely heavily and extensively on this interpretation.⁸

22. The Examiner maintains his interpretations as stated in the previous Office Actions. Again, to the extent that the Examiner's interpretations are either different from or in dispute with Applicants' interpretations, the Examiner hereby adopts the following additional definitions—under the broadest reasonable interpretation standard—in all his claim interpretations. Moreover, the following list is provided in accordance with *In re Morris* and is not intended to be exhaustive in any way:

Automatic "1 a : largely or wholly involuntary;" Merriam-Webster's Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

Associate: "1: closely connected with one another . . ." Id.

23. Because applicants frequently misunderstand the historical order of definitions and their corresponding senses, the following excerpts from the "Explanatory Notes" in Merriam-Webster's Collegiate Dictionary are provided:

⁸ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

Definitions

Division of Senses

A boldface colon is used in this dictionary to introduce a definition. . . . It is also used to separate two or more definitions of a single sense. . . . Boldface Arabic numerals separate senses of a word that has more than one sense. . . . Boldface lowercase letters separate the subsenses of a word. . . . Lightface numerals in parentheses indicate a further division of senses. . . .

...

Order of Senses

The order of senses within an entry is historical: the sense known to have been first used in English is entered first. This is not to be taken to mean, however, that each sense of a multisense word developed from the immediately preceding sense. It is altogether possible that sense 1 of a word has given rise to sense 2 and sense 2 to sense 3, but frequently sense 2 and sense 3 may have risen independently of one another from sense 1.

24. When a number sense is further subdivided into lettered subsenses, the include of particular subsenses with a sense is based upon their semantic relationship to one another, but their order is likewise historical: subsense 1a is earlier than subsense 1b, 1b is earlier than 1c, and so forth. Divisions of subsenses indicated by lightface numerals in parentheses are also in historical order with respect to one another. Subsenses may be out of historical order, however, with respect to the broader numbered senses. Merriam-Webster's Collegiate Dictionary, pp 19a-20a.

Response to Arguments

25. Applicant's arguments with respect to the prior art and the claims have been considered but are moot in view of the new grounds of rejection.
26. Regarding the anticipation rejections, Applicant is reminded that during ex parte examination, anticipation requires the examiner to meet the 'All Elements Test.' "It is axiomatic that anticipation of a claim under §102 can be found only if the prior art reference discloses

Art Unit: 3627

every element of the claim, and that anticipation is a fact question” *In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986); see also *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.”). In other words, all elements of the claimed invention must be disclosed in some fashion for the claim to be anticipated. Logically, the lack of a single structural element or step would negate anticipation. “[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

Yet it is important to keep in mind that “[a]n anticipatory reference, however, need not duplicate word for word what is in the claims.” *Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991). “While a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests” *In re Bell*, 991 F.2d 781, 785, 26 USPQ2d 1529, 1532 (Fed. Cir. 1993) (citations and quotations omitted).⁹ In other words, “[t]he use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983)(quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).¹⁰

⁹ See also *In re Widmer*, 353 F.2d 752, 757, 147 USPQ 518, 523 (CCPA 1965)(noting that a reference is not limited to its examples, but is available for all that it fairly discloses and suggests).

¹⁰ See MPEP §2123, Subsection titled “Patents Are Relevant as Prior Art for All They Contain.”

Conclusion

27. Applicant's amendment filed October 7, 2005 necessitated the new grounds of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

28. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

29. Unless expressly noted otherwise by the Examiner or other USPTO official, the following four (4) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action *and* any future office action(s), communication(s), or other correspondence provided by the USPTO: MPEP citations to Chapter 2300 are from the MPEP 8th Edition, Rev. 4, October 2005; citations to Chapters 200-900, 1200-1400, and 1700-1900, 2100, 2200, 2600 are from the MPEP 8th Edition, Rev. 3, August 2005. MPEP citations to Chapters 100, 1000, 1100, 1500, 2000, 2500, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. MPEP citations to Chapters 1600, 2300, 2400 are from MPEP 8th Edition, August 2001.

Art Unit: 3627

30. Additionally, Applicant is reminded that it is inappropriate for the USPTO to disregard any relevant evidence. “It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included.” *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871, 879 (Fed. Cir. 1983). Second, when making substantive patentability determinations, it is clear error for the USPTO not to consider *all* evidence of record. See *e.g. In re Piasecki*, 745 F.2d 1468, 1471, 223 USPQ 785, 787 (Fed. Cir. 1984) (“All the evidence on the question of obviousness must be considered.”); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (“After evidence or argument is submitted by the applicant in response, patentability is determined on *the totality of the record*, by a preponderance of evidence with due consideration to persuasiveness of argument. [Emphasis added.]”); *In re Glaug*, 283 F.3d 1335, 1338, 62 USPQ2d 1151, 1152-53 (Fed. Cir. 2002) (“Patentability vel non is then determined on the *entirety* of the record, by a preponderance of evidence and weight of argument. . . . ; patentability is determined by a preponderance of *all* the evidence. [Emphasis added.]”); and *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143, 146 (CCPA 1976)(where the court expressly set forth the issue as “Whether, in light of *all the evidence*, the claimed method would have been obvious at the time the invention was made. [Emphasis added.]”). Third, any factual determination by the USPTO that does not consider *all* relevant evidence may not be supported by substantial evidence¹¹ since the particular evidence *not* considered may be probative of a factual issue presented. Therefore because, inter alia, it is inappropriate for the USPTO to disregard any relevant evidence, because the USPTO must consider all evidence of record, and because any evidence *not* considered by the USPTO may be probative of at least one factual

¹¹ Substantial evidence is “such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938).

Art Unit: 3627

issue presented, Applicant is hereby given actual notice that all prior art rejections (*i.e.* rejection(s) based upon 35 U.S.C. §§ 102 or 103)—if found in this Office Action or any subsequent office action—are based upon the cited reference(s) in the statement of the rejection in combination with the knowledge of one of ordinary skill in this art. *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962).

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

32. Applicant is reminded that patents are written by and for skilled artisans. See *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”). The Examiner therefore starts with the presumption that Applicants are skilled artisans who possess at least ordinary skill in the art. Consequently, it is the Examiner’s position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicant is hereby given actual notice that

Art Unit: 3627

if after reasonably reading any reference of record, if Applicant can not reasonably understand or if Applicant has difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in one or more of the reference(s) of record, Applicant should (in his next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicant's response must also state *why* he either does not understand the reference or has difficulty comprehending the reference. If after properly receiving (*i.e.* Applicant's response is made of record) both Applicant's request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) at issue in a reasonable manner.

33. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an

Art Unit: 3627

Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

34. Also in accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the reference The Bank Credit Card Business by the American Bankers Association (hereinafter "ABA") is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. The Examiner finds that ABA is a textbook that introduces the reader to the dynamic bank credit card business. The reference is cited in its entirety. Moreover, because of the reference's general description of the credit card business, because "[w]ell known text books in English are obvious research materials," *In re Howarth*, 654, F.2d 103, 210 USPQ 689, 692 (CCPA 1981), and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that ABA is primarily directed towards those of low skill in this art. Because ABA is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must-at the very least-be aware of and understand the knowledge and information contained within ABA.

35. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks" (beginning on page 5) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal

Art Unit: 3627

conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹² the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Alexander Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.



Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
December 29, 2005

¹² *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.